

This Opinion is Not a
Precedent of the TTAB

Mailed: March 16, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jon Wayne Heating & Air Conditioning, Inc.

Serial No. 87065528

Cline H. White of Jackson Walker LLP,
for Jon Wayne Heating & Air Conditioning, Inc.

Edward Fennessy, Trademark Examining Attorney, Law Office 114,
Nicole A. Nguyen, Managing Attorney.

Before Wellington, Lykos, and Greenbaum,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Jon Wayne Heating & Air Conditioning, Inc. (“Applicant”) seeks registration on the Principal Register of the mark shown below for an extensive list of services, including contractor, repair, installation, maintenance, and technical support services in the fields of heating, ventilation, air conditioning, plumbing, insulation, solar energy, and home automation, all in International Class 37:



The mark is described in the application as “consist[ing] of the letters ‘JW’ surrounded by an open lariat above and below the letters.”

The Examining Attorney refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with the registered standard character mark **JW HOME IMPROVEMENT** (on Principal Register with a disclaimer of HOME IMPROVEMENT) for:²

Handyman services, namely, custom carpentry, building repair and maintenance, namely, interior and exterior carpentry, interior and exterior painting and staining, drywall patching and repair, power washing, art and mirror hanging, TV mounting, gutter and downspout installation, cleaning, repair and replacement, faucet and toilet installation and adjustments, smoke detector replacement, tile repair and re-grouting, backsplash installation and repair, caulking, wood rot repair, attic stairs installation and repair, shelf and cabinet installation and repair, exterior deck installation and repair; complete bathroom and kitchen remodeling services, in International Class 37.

Applicant requested reconsideration of the refusal and filed an appeal with this Board. Applicant’s request for reconsideration was denied by the Examining Attorney and this appeal resumed. The appeal has been fully briefed. For the reasons set forth below, we affirm the refusal to register.

¹ Application Serial No. 87065528, filed on June 9, 2016, under Section 1(a) of the Trademark Act (“the Act”), 15 U.S.C. § 1051(a), based on an allegation of first use of the mark in commerce on December 31, 2013.

² Registration No. 6182349, issued on October 27, 2020.

I. Examining Attorney's Objection

The Examining Attorney argues that Applicant's appeal brief is "late and should not be considered and applicant's appeal should be dismissed."³

Trademark Rule 2.142(b)(1) which provides, in relevant part, that "if the brief is not filed within the time allowed, the appeal may be dismissed." *See also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 1203.02(a) (2022). The permissive term "may" in the rule gives the Board discretion to consider whether dismissal of an appeal based on an untimely brief is appropriate.

The Examining Attorney is correct in that Applicant's brief is untimely, albeit by only one day.⁴ However, as stated in the Board's order forwarding the file to the Examining Attorney for briefing, the Board determined that Applicant's "explanation of its late-filed brief is noted and accepted."⁵ In other words, the Board already exercised its discretion and accepted the brief. Accordingly, Applicant's appeal brief is considered, and the Examining Attorney's request that the Board not consider Applicant's brief and dismiss the appeal is denied.

³ 21 TTABVUE 6.

Unless otherwise specified, all TTABVUE and TSDR citations refer to the docket and electronic file database for Application Serial No. 88195064. All citations to the TSDR database are to the downloadable .pdf version of the documents.

⁴ 18 TTABVUE. Applicant's appeal brief was due on August 15, 2022 pursuant to the Board's June 16, 2022 resumption order (17 TTABVUE) and it was filed on August 16, 2022.

⁵ 19 TTABVUE 1 (Note 1).

II. Likelihood of Confusion

Our determination under Section 2(d) involves analyses of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as “*DuPont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the goods and/or services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”). We discuss below these and other relevant factors. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019) (Board considers each *DuPont* factor for which there is evidence and argument).

A. Relatedness of the Services; Trade Channels

We begin our analysis with the second and third *DuPont* factors that, respectively, involve the “similarity or dissimilarity and nature of the goods or services as described in an application or registration” and the “similarity or dissimilarity of established, likely-to-continue trade channels.” *DuPont*, 177 USPQ at 567. It is “not necessary that the goods [or services] be identical or even competitive to support a finding of a likelihood of confusion.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668

F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). “[L]ikelihood of confusion can be found ‘if the respective goods [or services] are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’” *Id.*

Also, under the similarity of the services *DuPont* factor, the Examining Attorney need not prove, and we need not find, similarity as to each and every service listed in the description of services. It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any separate service listed within the application’s recitation. *Tuxedo Monopoly, Inc. v. General Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). *See also In re i.am.symbolic, llc*, 116 USPQ2d at 1409; *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014).

In addition, and relevant to our analysis in light of Applicant’s arguments, when services are separated by semicolons in the identifications, they are considered distinct categories of services. *See Monster Energy v. Lo*, 2023 USPQ2d 87, at *15 n.35 (citing TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1402.01(a) (“semicolons should generally be used to separate distinct categories of goods or services within a single class”). *See also Paula Payne Prods. Co. v. Johnson Publ’g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) (Board must “give full sweep” to an identification of goods regardless of the registrant’s actual business). Thus, although Applicant has prefaced by or used the term “contractor” as to some services, other categories of services in its identification are not restricted or modified by this term.

With the above principles in mind and upon review of the recitations of services in the application and registration, we find certain services listed in the application encompass some of the services listed in the registration. That is, Applicant's "plumbing" and "plumbing installation" services cover Registrant's more specific "faucet and toilet installation and adjustments" services. Conversely, Registrant's "complete bathroom and kitchen remodeling services" encompass or are very closely-related to Applicant's "installation, maintenance and repair of ... plumbing, and electrical systems and equipment" services. In other words, Registrant's remodeling services entail, in part, the installation of plumbing, or electrical systems and equipment. To the extent that the services overlap, they are legally identical.

Despite the in-part legal identity or otherwise close relationship of the services, Applicant argues that there are "very real differences between the [Applicant's and Registrant's] services, such as licensing, size and scope of jobs, and types of jobs."⁶ Specifically, Applicant asserts that it is a general contractor whereas Registrant performs handyman services, and that:⁷

[o]ne of the main differences between a handyperson and a general contractor is licensure. A handyman, such as the registrant's services description includes, isn't licensed. A contractor, such as Applicant's services description includes, is required to be licensed. As a result, Registrant handyman cannot compete with the Applicant contractor.

The problem with Applicant's argument is that not all of its services are prefaced as "contractor" services. Indeed, where Applicant's services are legally identical to

⁶ 22 TTABVUE 3.

⁷ *Id.*

Registrant's services, these are not prefaced as "contractor" services nor are they confined to being rendered by a licensed contractor. For example, Applicant's "plumbing installation" would include the installation of a toilet, which Registrant does, and it has not been shown that such services must be performed by a contractor.

The Examining Attorney also submitted evidence showing a relationship between "handyman" services, like Registrant's, and many of the same services rendered by Applicant, including "contractor" services. The evidence includes 12 third-party, use-based registrations for marks that cover both these services.⁸ These registrations are probative value to the extent that they serve to suggest that the listed services are of a type which may emanate from the same source. *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

Additionally, the Examining Attorney submitted Internet evidence showing a single entity advertising both handyman services and identifying itself as a contractor.⁹ For Example, "Long Handyman Services" advertises "general contractor"

⁸ Attached to Office Action issued on October 4, 2021, TSDR pp. 2-37. Examples of these third-party registrations include: HUSBAND FOR A DAY WE DO WHAT YOU SAY (Reg. No. 3479581) for various "general handyman services" as well as various "general contractor services"; BRANDPOINT SERVICES (Reg. No. 3909399) for various "handyman services" as well as "HVAC contractor services" and other "contractor" services; OPC (Reg. No. 4620944) for "handyman services, namely, building repair and maintenance; building construction, remodeling and repair; ... electrical subcontracting; HVAC subcontracting; ... general building contractor services; [and] general construction contracting"; and DON'T GAMBLE, CALL CAMPBELL (Reg. No. 6399624) for "electrical contractor services ...; plumbing services; general handyman services, namely, building repair and handyman"

⁹ *Id.* at TSDR pp. 38-73.

services on its website and as well “heating ... plumbing ... electrical ...” services on its truck:



[red arrows inserted for emphasis].

Another example, “Palm Desert Contractor & Handyman” offers both “handyman” and “contractor” services to “residential & commercial” customers:

¹⁰ *Id.*, at TSDR p. 40.



. 11

The third-party Internet evidence showing the same mark used by the same entities for some of Applicant’s and Registrant’s services is probative to demonstrate that the services are related for likelihood of confusion purposes. *See, e.g., In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018) (relatedness supported by evidence showing that “consumers are accustomed to seeing a single mark associated with a source that sells both.”); *In re Anderson*, 101 USPQ2d 1912, 1920 (TTAB 2012) (Internet excerpts from “several third-party car dealerships offering ‘tires’ for sale on their websites” was “evidence that consumers expect to find both ‘tires,’ . . . “and ‘automobiles’ . . . emanating from a common source.”).

As to the trade channels for the involved services, because some of Applicant’s services overlap with or are otherwise legally identical to some of Registrant’s

¹¹ *Id.* at TSDR p. 50.

services, we presume that these services travel through at least some of the same channels of trade to the same classes of purchasers. *See Am. Lebanese Syrian Assoc. Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011) (where the services were legally identical, “the marketing channels of trade and targeted classes of consumers and donors are the same”); *see also In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion). In other words, a consumer in need of “plumbing” or “plumbing installation” may retain Applicant or Registrant to render these services.

As the Internet evidence further bears out, Registrant’s handyman services and Applicant’s contractor services will also be found in some of the same trade channels, namely, offered by a single entity advertising on a single website. In other words, if a consumer is seeking handyman services or contractor-type services in the fields of HVAC and plumbing, these services may be advertised in the same place.

Accordingly, the *DuPont* factors regarding the relatedness of the services and their trade channels strongly favor a finding of likelihood of confusion.

B. Similarity of the Marks

The marks:



and **JW HOME IMPROVEMENT**, are overall very similar “in their entireties as to appearance, sound, connotation and commercial impression.” *Palm*

Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567).

Applicant argues that the design element of its mark is:

(1) an inseparable portion of the mark in its entirety, (2) presented in a stylish and distinctive typeface, (3) ...unitary, and (4) present[ed] as a western brand.

While Applicant is correct that the two marks must be considered in their entireties, it is settled that a single feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the similarity of the marks. *In re Viterra Inc.*, 101 USPQ2d 1908; *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (“There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.”). In this case, both marks are dominated by the same letters or initials “JW.”

Notwithstanding the design element in Applicant’s mark, it is the letters, as the sole literal element, that will make the strongest impression on consumers. *Viterra*, 101 USPQ2d at 1911 (“the verbal portion of a word and design mark likely will be the dominant portion”). *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987) (holding that “if one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services” and “because applicant’s mark shares with registrant’s

mark that element responsible for creating its overall commercial impression, the marks are confusingly similar”).

Applicant’s argument that its mark “presents as a western brand” is acknowledged and the design element is certainly one difference between the marks, but there is no evidence to showing that consumers will perceive it as a “western brand.” The design also does not make such a strong commercial impression for purposes of distinction. We must also keep in mind that the test for similarity of the marks is not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the services offered under the respective marks is likely to result. *Coach Servs.*, 101 USPQ2d 1721; *see also Edom Labs. Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012). Consumers recalling Applicant’s mark are unlikely to attempt describe or verbalize the design element, but will likely speak out the letters “JW.”

With respect to Registrant’s mark, the letters JW make the strongest commercial impression because they appear first and will be the primary distinctive element of the mark. The disclaimed additional wording, HOME IMPROVEMENT, is highly descriptive and does extremely little in terms of distinguishing Registrant’s mark as a source-identifier in connection with the home improvement services like those listed in the registration. *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997) (disclaimed matter that is descriptive of or generic for a party’s goods is typically less significant or less dominant when comparing marks); *see also In re*

Aquitaine Wine USA, 126 USPQ2d 1181, 1188 (TTAB 2018) (“consumers often have a propensity to shorten marks” when ordering goods or services).

In terms of the marks’ meaning or connotation, the letters JW obviously do not form a word. While JW can be viewed as initials for an individual’s or company name, particularly in the case of Applicant, Jon Wayne Heating & Air Conditioning, Ltd., there is no certainty that consumers will be aware of any such abbreviation. Because there is no evidence that JW has any meaning in connection with the involved services and there is no evidence of weakness based on third-party use of the same letters, we must anticipate that Applicant and Registrant may be the only entities to employ these same two letters in their marks for the involved services which, as discussed, are in-part legally identical. *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (“when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines”).

In sum, we find the involved marks are overall more similar than not. Accordingly, this *DuPont* factor weighs in favor of likely confusion.

C. Sophistication of Consumers

Under the fourth *DuPont* factor, we consider “[t]he conditions under which and buyers to whom sales are made, i.e., ‘impulse’ vs. careful, sophisticated purchasing.”

DuPont, 177 USPQ at 567. Applicant makes the argument that confusion is not likely because:¹²

Average individual purchasers of services to their home or business, such as those who seek Applicant's services, are careful, experienced sophisticated commercial purchasing agents employed for their expertise in paying the least for the most professional contractor services. Likewise, homeowners are very focused on providing the best for their homes. Building transactions are typically for many thousands of dollars and between repeat buyers and sellers.

Even home owners seeking more general handyman services want the work in their homes to be excellent, and will focus on who is providing the services.

There is no evidence of record to support Applicant's conclusory assertions, and argument is no substitute for evidence. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018), *citing Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 1284 (Fed. Cir. 2005). Moreover, as discussed, the application describes Applicant's services to include "plumbing ... plumbing installation ... plumbing installation ... installation, maintenance and repair of commercial and residential heating, air conditioning, ventilation, plumbing, and electrical systems and equipment." These services are not restricted, either in the recitation of services or by their very nature, to a consumer base comprising "sophisticated commercial purchasing agents," nor are these necessarily "professional contractor services." Indeed, these services would include smaller jobs that are not very complicated or expensive, such as fixing a leaky faucet or installing a window air conditioner, and we cannot assume that a homeowner consumer would exercise any more care than

¹² 18 TTABVUE 17.

the average consumer in their selection of a handyman or contractor to complete this work.

Applicant's and Registrant's services, as described in the application and registration, include services to your average homeowner. Although it may be a reasonable assumption that homeowners, like any other recipient of services, seek "excellent" services, this hardly qualifies them as sophisticated purchasers. We must anticipate the least-sophisticated consumer who, in this case, may have no special knowledge as to plumbing repairs or installation and would not necessarily exercise heightened care. *See Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1163 (Fed. Cir. 2014) ("Board precedent requires the decision to be based 'on the least sophisticated potential purchasers.'") (quoting *Gen. Mills, Inc. v. Fage Dairy Proc. Indus. S.A.*, 100 USPQ2d 1584, 1600 (TTAB 2011), *judgment set aside on other grounds*, 2014 WL 343267 (TTAB 2014)). Even homeowners who are careful in selecting a company to install plumbing fixtures may be confused as to source where similar marks are used in connection with the same or closely-related services. *See In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (citing *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970)) ("Human memories even of discriminating purchasers ... are not infallible.").

Accordingly, this *DuPont* factor is neutral.

III. Conclusion



Because the marks  and **JW HOME IMPROVEMENT**, are overall very similar, we find that when they are used in connection with legally identical or otherwise closely related services, and that these services will be offered in the same trade channels to the same classes of purchasers, confusion is likely.

Decision: The refusal to register Applicant's mark is affirmed.